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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,700	12/08/2003	Karl Rafeld	KWO-18502/01	3992

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EXAMINER

NGUYEN, SON T

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/730,700

Applicant(s)

RAFELD, KARL

Examiner

Son T. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

*Son T. Nguyen*  
*Prim Exm 3643*

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 12/8/03 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 12/12/02. It is noted, however, that applicant has not filed a certified copy of the DE 20219286.5 application as required by 35 U.S.C. 119(b).

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-12** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Applicant is encourage to rewrite the claims to conform to US practice.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1,2,6-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over US 3952807 (herein 807) in view of US 6401828 (herein 828).

For claim 1, 807 discloses a hoof pad lining comprising a flat plate of flexible plastic material; and tube-like hump having a circular hollow space filled with air. However, 807 is silent about the hollow space being oval, a bridge-like connecting bar and the hump extending to the connecting bar. It would have been an obvious substitution of functional equivalent to substitute the circular hollow space of 807 with an oval hollow space, since it would perform the same function; i.e. to prevent snow and ice from entering the horseshoe.

828 teaches hoof pad having bridge-like connecting bar 111 and lining 128,129 extending to the connecting bar. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ bridge-like connecting bar as taught by 828 on the horseshoe of 807 to transfer pressure forces (col. 2, lines 1-10 of 828). Note, 807 as modified by 828 would result in the lining stopping at the connecting bar due to the presence of the bar itself to prevent the lining to extend to the end of the horseshoe.

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For claim 2, 807 as modified by 828 (emphasis on 807) discloses the hollow space is continuous with the exception of the interruption (at ref. 14) at the front end (col. 2, lines 60-68).

For claim 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the size of the cross section of the hollow space of 807 as modified by 828 covers  $\frac{1}{3}$  up to  $\frac{1}{2}$  of the entire cross section of the hump, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art.

For claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the hollow space of 807 as modified by 828 in the upper half of the cross section of the hump, depending on how deep one wishes to place the pad lining inside the horseshoe so that the hollow space can be exposed to prevent snow and ice from entering.

For claim 8, it would have been an obvious substitution of functional equivalent to substitute the circular hollow space of 807 as modified by 828 with two distantly arranged, parallel, upright standing ellipses, since it would perform the same function; i.e. to prevent snow and ice from entering the horseshoe.

For claims 9 & 10, it would have been an obvious substitution of functional equivalent to substitute the circular hollow space of 807 as modified by 828 with two distantly arranged, same size, parallel, lying ellipses, since it would perform the same function; i.e. to prevent snow and ice from entering the horseshoe.

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For claim 11, 807 as modified by 828 discloses the hollow space can elastically be pressed together under the weight of the horse and will be released into the original condition after deloading.

For claim 12, 807 as modified by 828 discloses the ends of the hollow space are open.

7. **Claims 3-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over 807 as modified by 828 as applied to claim 1 above, and further in view of US 6244352 (herein 352).

For claim 3, 352 teaches a pad lining having ellipse hollow space as shown in fig. 17. It would have been an obvious substitution of functional equivalent to substitute the circular hollow space of 807 as modified by 828 with the elliptical hollow space of 352, since it would perform the same function; i.e. to prevent snow and ice from entering the horseshoe.


For claim 4, the combination of 807 as modified by 828 & 352 teaches the elliptical hollow space is placed upright such that its small axis extends parallel to the hoof sole and its large axis extends parallel to the height of the hump.

For claim 5, it would have been an obvious substitution of functional equivalent to substitute elliptical hollow space of 807 as modified by 828 & 352 placed upright such that its small axis extends parallel to the hoof sole and its large axis extends parallel to the height of the hump. with the elliptical hollow space arranged lying such that its large axis extends parallel to the hoof sole and its small axis extends parallel to the height of

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the hump., since it would perform the same function; i.e. to prevent snow and ice from entering the horseshoe.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 872-9325. The official fax number is 703-872-9306.

  
Son T. Nguyen  
Primary Examiner, GAU 3643  
May 1, 2004